

REMARKS UNDER 37 C.F.R. § 1.111

Formal Matters

Attached hereto is a marked-up version of the changes made to the Specification by the current amendment. The attached is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**"

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein. No new matter has been added.

COMMON OWNERSHIP

The claimed invention was subject to obligations of common ownership prior to any later-invented variation was made. An Assignment will be filed in the present application memorializing the agreement made to this effect by the joint inventors.

IN THE DRAWINGS

The outer translucent member of the claim 20 is described, for example, in the last two sentences of paragraph [0016]. It is specifically referenced in element 719 in paragraph [0051]. Withdrawal of the objection under 37 C.F.R 1.83(a) is therefore requested.

As to the noted dual use of the reference numeral "108" for the light source and inner cylinder, by way of the above amendment to the specification the matter has been addressed. Withdrawal of the objections under 37 C.F. R. 1.84 (p)(4) is therefore requested.

Regarding use of both "304a" and "304a" in reference to the mounting arm, Applicants are not sure what the Examiner means. In reviewing a copy of the application as filed, it appears to Applicants that the vertical arms referenced at page 12, line 25 do indeed appear as "304a" and 304b." Whereas Applicants will ultimately submit formal drawings making this even more clear, they are unsure as to the nature of the rejection and request clarification by the Examiner – or in the alternative, withdrawal of the rejection.

CLAIM REJECTIONS

Claims 16, 17, 19, and 20 we rejected in view of combinations including Murch as a base reference. However, the Examiner has failed in each instance to meet the burden imposed by the requirements of a *prima facie* case for obviousness. Particularly, no motivation has been expressed for

providing a translucent screening member to tint or diffuse light; no motivation has been provided to provide an opaque folding door to conceal the light source; and no motivation has been expressed for providing a translucent screening member outside opaque member outside of another translucent member.

Without expressing some motivation or suggestion to employ the referenced features, a complete rejection has not been provided. All that has been said regarding the claims is therefore believed to amount to hindsight restrictions.

In further considering the question of motivation, Applicants wish to note that the Murch reference is designed to provide intense illumination by concentrating light with its mirrors. It is designed to brightly illuminate oppositely directed paths or areas. Therefore, introducing a member to diffuse or tint light is contrary to the purpose of the reference. The reference describes the lamp as useful where lateral provision of light is not needed. Thus combining Murch with Barnes is not believed supported.

Aside from this, it is clear to Applicant that Barnes fails to disclose a “translucent” member “J” as required by the claims. As clearly stated in the references, element “J” is a colored glass cylinder. Please see paragraph [0017] of Applicants specification for the meaning of “translucent” required by claim 16, 17, 19 and 20.

In addition to the inadequacy of the Murch/Barnes combination, upon which all the rejections of claims 16, 17, 19 and 20 rely, together with the lack of any started motivation for that combination or the other combinations (*i.e.*, Murch/Barnes/Webber for claim 19 and Murch/Barnes/Simpson for claim 20) these further combinations are flawed. The shade “g” in Webber is clearly not a folding door that may be opened and closed as required of claims 19. Figure 3 does not even teach opening the shade, but is rather a cross-section view. As to Simpson, it does not disclose a translucent screening member concerning at least a portion of an opaque screening portion. The so-called “opaque screening member” referenced character B” is not opaque in the sense required by Applicant. Again, please see paragraph [0017] of Applicants’ specification. In the reference, screen B is a transparency strip: it is anything but impenetrable by light.

For any of the foregoing reasons, claims 16, 17, 19 and 20 are believed to be in condition for allowance, which action is respectfully requested. In the event any of the rejections are to be maintained despite the clear and distinguishing meaning of “translucent” and “opaque” noted with respect to the

cited references, Applicants respectfully request in advance a telephonic interview with the Examiner – prior to issuance of another Office Action.

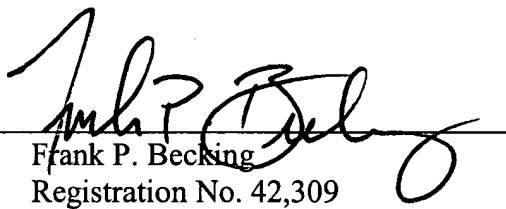
Conclusion

In view of the foregoing remarks Applicants submit that all of the claims are in condition for allowance, which action is requested.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number DTKA-002.

Respectfully submitted,
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Date: 12/30/02

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

[0038] In operation of this preferred embodiment, the light source 108 would be turned on, for example, before sunset on Friday night. First, bases 104, 120 would be brought together to make the surfaces 122, 124 flush and to cause the light source 108 to fit through the aperture 128 and fully within the enclosure formed by the outer and inner [and outer] cylinders 130, 132. It should be understood that, in accordance with religious observance requirements, the element 108 should not touch the wall of the inner cylinder [108] 130 during the use of Shabbos. Thereafter, the plug 116 would be placed into an electrical outlet to provide electricity to the light source 108 and the switch 117 would be turned “on” to the cause the light source 108 to generate light.